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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/760,017	01/16/2004	Uwe Steinhardt	2869	9631

7590 09/15/2004

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Huntington, NY 11743

EXAMINER

ISABELLA, DAVID J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/760,017	Applicant(s) STEINHARDT ET AL. <i>CH</i>	
	Examiner DAVID J ISABELLA	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/10/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,5,7,8,9,10 are rejected under 35 U.S.C. 102(e) as being anticipated by Kurz (6579317).

Kurz discloses an auditory ossicles prostheses, comprising a head plate (53) adapted to be placed on an ear drum; a base part (50) formed so as to receive a rising bracket or to be placed in an oval window of a rising bracket foot plate, and means for movably connecting said head part with said base part, said means for movably connecting said head part with said base pad being formed as a flexible wire (52).

Claim 5, see figure 5.

Claim 7, see base part 50, including spring-like fingers.

Claim 8, the material of Kurz is biocompatible, see claim 6.

Claims 9 and 10, see claims 7 and 8.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2,3,11,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz (6579317) as applied to claim 1 above, and further in view of Knox et al (6197060).

Knox, et al teaches the use of a nickel-titanium alloy (nitinol) as the biocompatible material for ossicles prosthesis. Nitinol has shape memory properties which allows for the shaft to assume a proper configuration to provide for positively engaging the elements of the ossicular chain. To use nitinol for it's shape memory properties in the manufacturing of the shaft of Knox, et al to provide for positive engagement of the prosthesis to the ossicular chain would have been obvious from the teachings of Knox, et al.

Claim 3, Knox, et al discloses in the background of the invention the prior art use of steel for the wire element of the prosthesis.

Claim 11, see rejection to claim 2 supra.

Claim 12, see rejection to claim 3 supra.

Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz (6579317) as applied to claim 1 above, and further in view of Prescott (6168625).

Prescott teaches the feature of the offset connection between the head and the shaft and the general range for the wire diameter. Kurz is silent to the diameter of the wire and shows only the connection between the head and the shaft to be centered. In view of Prescott, one with ordinary skill in the art would use the teachings as a generally

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acceptable range for wire diameters to fall between 0.1-0.5mm. Likewise, depending on the configuration of the patient's ossicular chain, offsetting the connection between the head and the shaft may be preferred over the centered connection as shown.

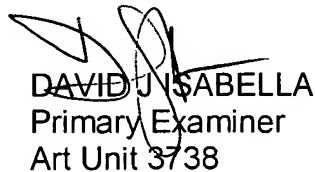
Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kurz (6579317) as applied to claim1 above, and further in view of Huttenbrink (DE 19744789).

The embodiment showing the connecting fingers (50) is not clearly depicted. If not inherent, a bell shaped base part for receiving a bracket or a ossicular element is taught by Huttenbrink. The use of a bell shaped base part for postive linking of the head to the ossicular element would have been obvious to one with ordinary skill in the art based on equivalent function for linking the ossicular element to the prosthesis.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J. SABELLA
Primary Examiner
Art Unit 3738

DJI
September 8, 2004